

### **REMARKS**

In view of the above amendments and the following remarks, reconsideration of the rejections and objections, and further examination are requested.

Claims 15-28 were pending in this application and stand rejected. Claims 15, 18-22 and 26-28 are amended herein. No new matter has been added.

Claims 17-19 and 21-25 have been objected to on the basis that they describe desired functional results for previously recited elements/sections.

As discussed in MPEP § 2173.05(g), “There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper . . . A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used.” Thus, the Applicants respectfully submit that the functional language recited in claims 17-19 and 21-25 is proper.

The Examiner also asserted that claims 17-19 and 21-25 are not written in the standard means plus function language allowed/permitted by present USPTO practice, i.e., paragraph four under 35 U.S.C. § 112. However, the fourth paragraph of 35 U.S.C. § 112 requires that “a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed,” and does not address means-plus-function type claim language. Rather, the sixth paragraph of 35 U.S.C. § 112 addresses means-plus-function claim language. Regardless, none of claims 15-28 recites features using means-plus-function type claim language. Thus, the Applicants respectfully submit that the Examiner’s objection to claims 17-19 and 21-25, on the basis that they are not written in standard means plus function language, is improper.

Accordingly, the Applicants respectfully submit that the objections to claims 17-19 and 21-25 be withdrawn.

Claims 17, 20 and 27 have been rejected under 35 U.S.C. § 112, second paragraph, on the basis that they are indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. Specifically, the Examiner asserted that as

recited in dependent claims 17 and 20, the “the DMA is to record/store appropriate OPC information. Because the term DMA is a defined concept/terminology accepted and in standard use in this environment, the renaming of such is not in keeping with such accepted terminology and would of course cause confusion.” However, neither claim 17 nor claim 20 recites “DMA” as asserted by the Examiner. Instead, each of claims 17 and 20 recite registering certain areas as “defective areas” and is consistent with the specification. Support for such designations can be found in the specification on page 9 starting at line 7 and ending at line 26. As described therein, DMA is a “defect management area 240,” and is for storing a list showing information on the position of a defective area and information on the position of an alternate area with the defective area.

Moreover, the Examiner is reminded that the words of a claim must be given their plain meaning unless the plain meaning is inconsistent with the specification. *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) (discussed below); *Chef America, Inc. v. Lamb-Weston, Inc.*, 358 F.3d 1371, 1372, 69 USPQ2d 1857 (Fed. Cir. 2004) (Ordinary, simple English words whose meaning is clear and unquestionable, absent any indication that their use in a particular context changes their meaning, are construed to mean exactly what they say).

Consequently, the Applicants respectfully submit that claims 17 and 20 are definite and comport with the description provided in the specification of this application.

Claim 27 has been amended to recite “An access unit which includes a recording section for recording data in a record medium that includes a user area for recording user data which is recorded and regenerated based on an instruction given by a user, a reading section for reading data from the record medium, and a computer-readable recording medium having recorded thereon an access program for causing the access unit to execute at least the following:” Thus, amended claim 27 has been amended to address the Examiner’s concerns.

Accordingly, the Applicants respectfully submit that the 35 U.S.C. § 112, second paragraph rejection of claims 17, 20 and 27 be withdrawn.

The claims have been rejected as follows.

Claims 15, 16, 18, 19, 21-23, 25, 26 and 28 have been rejected under 35 U.S.C. § 102(b) as being anticipated by the acknowledged prior art (hereinafter referred to as APA) referenced in paragraphs 2-5 of the disclosure.

Claims 17 and 21 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over the arts as applied to claims 1, 5 and 19, and further in view of either Lee (U.S. Patent No. 7,286,454) (hereinafter referred to as “Lee”), Kelly et al. (U.S. Patent Application Publication No. 2002/0114244) (hereinafter referred to as “Kelly”) or Kobayashi (U.S. Patent No. 7,190,655) (hereinafter referred to as “Kobayashi”). Applicants note that claims 1 and 5 were cancelled in the Preliminary Amendment filed on August 31, 2006, and that claims 17 and 21 do not depend from claim 19. Instead, claims 17 and 21 depend from claims 16 and 18, respectively. Thus, Applicants have considered the rejection under 35 U.S.C. § 103(a) as being unpatentable over the arts as applied to claims 16 and 18, instead of to claims 1, 5 and 19.

Claim 14 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over the art as applied to claims 15 and 23, and further in view of either Nakajima (U.S. Patent Application Publication No. 2003/0067998) (hereinafter referred to as “Nakajima”).

Independent claims 15 and 26-28 have been amended to distinguish over the references cited by the Examiner.

The above rejections are submitted to be inapplicable to the amended claims for the following reasons.

In contrast to the present invention as recited in claim 15, the APA referenced in paragraphs 2-5 of the disclosure does not disclose an access unit, which accesses a record medium that includes a user area, and includes, in part, a recording section for recording test data based on a predetermined test condition in the user area during recording of user data in the user area.

Instead, the APA describes obtaining a record medium’s reliability by executing a test process for determining an optimum access parameter in a recording and regenerating unit to adjust an access parameter for a record medium. The access parameter is adjusted based on the result of a test record and a test regeneration for a read-in area or a readout area. In the test process, an optical head has to seek a read-in area or a read-out area, so that a test record and a

test regeneration can be made for the read-in area or the read-out area. Thus, the test process takes a longer time which causes disturbances in the regeneration of AV data, breaks in the recording of a picture, and lengthening the time to execute to recording of user data. Moreover, there is no disclosure or suggestion in the APA to modify the test process such that an optical head has to seek a user area of the recording medium.

Consequently, the APA does not disclose a recording section for recording test data based on a predetermined test condition in the user area during recording of the user data in the user area. As a result, the APA cannot provide the advantages of the claimed invention. That is, the APA cannot reduce the seek time of an optical head to record and regenerate test data.

For at least the reasons discussed above, it is believed clear that the APA fails to disclose or suggest the present invention as recited in claim 15.

Regarding the combination of the APA and Lee, Lee is relied upon in the rejection as teaching “a relocation of previously defined opc areas well-known in this environment.” However, it is clear that Lee also fails to disclose or suggest the above-discussed distinguishing features of the access unit recited in claim 15.

Regarding the combination of the APA and Kelly, Kelly is also relied upon in the rejection as teaching “a relocation of previously defined opc areas well-known in this environment.” However, it is clear that Kelly also fails to disclose or suggest the above-discussed distinguishing features of the access unit recited in claim 15.

Regarding the combination of the APA and Kobayashi, Kobayashi is also relied upon in the rejection as teaching “a relocation of previously defined opc areas well-known in this environment.” However, it is clear that Kobayashi also fails to disclose or suggest the above-discussed distinguishing features of the access unit recited in claim 15.

Claims 26-28 are patentable over the references relied upon in the rejections for reasons similar to those set forth above in support of claim 15. That is, each of claims 26-28 similarly recite instructing a recording section to record test data based on a predetermined test condition in a user area during recording of user data in the user area.

Claim 19 is allowable on its own merits because it recites that the recording section begins recording the test data from a position which is a predetermined distance from, in the

radial direction of the record medium, a position in which user data finishes being recorded within the user area, and begins recording user data from a position which is a predetermined distance from, in the radial direction of the record medium, a position in which the test data finishes being recorded. None of the references applied by the Examiner discloses this feature of claim 19.

For at least the reasons set forth above, it is believed clear that claims 15 and 26-28 are not anticipated by the APA under 35 U.S.C. § 102(b). Furthermore, for at least the reasons set forth above, it is respectfully submitted that one of ordinary skill in the art at the time the invention was made would not have found it obvious to modify the APA under 35 U.S.C. § 103(a) in such a manner as to result in the invention of claims 15 and 26-28. Therefore, it is respectfully submitted that claim 15, and claims 16-25 depending therefrom, and claims 26-28 are clearly allowable over the prior art of record.

In view of the foregoing amendments and remarks, all of the claims now active in this application are believed to be in condition for allowance. Reconsideration and favorable action are respectfully solicited.

Should the Examiner believe there are any remaining issues that must be resolved before this application can be passed to issue, it is respectfully requested that the Examiner contact the undersigned by telephone in order to resolve such issues.

Respectfully submitted,

Harumitsu MIYASHITA et al.

/Kevin McDermott/  
2008.11.24 11:18:14 -05'00'

By: \_\_\_\_\_  
Kevin McDermott  
Registration No. 48,113  
Attorney for Applicants

KM/kh  
Washington, D.C. 20006-1021  
Telephone (202) 721-8200  
Facsimile (202) 721-8250  
**November 24, 2008**